



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,361	03/16/2001	Catherine Guenther	R-125	7726

7590 12/03/2001
DELTAGEN, INC.
ATTN: JOHN E. BURKE, ESQ.
1003 HAMILTON AVENUE
MENLO PARK, CA 94025

EXAMINER

QIAN, CELINE X

ART UNIT	PAPER NUMBER
----------	--------------

1633

DATE MAILED: 12/03/2001

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,361

Applicant(s)

GUENTHER, CATHERINE

Examiner

Celine Qian

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-37 are pending in the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 17-21, drawn to a targeting construct, a method of making said targeting construct, a cell comprising a disruption in a retina-specific nuclear receptor gene, a retina-specific nuclear receptor gene knockout non-human animal and a method of making said non-human animal, classified in class 536, subclass 230.1, class 435, subclass 91.41, class 800, subclass 13 and 21.
- II. Claims 11, 13, 29, 30, 33 and 34, drawn to a method of identifying an agent that modulates retina-specific nuclear receptor gene expression, classified in class 800, subclass 3.
- III. Claims 12, 14, 35 and 36, drawn to a method of identifying an agent that modulates retina-specific nuclear receptor gene function, classified in class 800, subclass 3.
- IV. Claim 16, drawn to an agent that modulates retina-specific nuclear receptor gene expression or function, classified in class 800, subclass 3.
- V. Claims 25-28, 31 and 32, drawn to a method of identifying an agent that ameliorate an eye abnormality, classified in class 800, subclass 3.
- VI. Claim 37, drawn to an agent that modulates retina-specific nuclear receptor gene expression/function or ameliorates eye abnormality, classified in class 800, subclass 3.

Art Unit: 1633

Claim 15 is generic to groups II and III and will be examined in so far as it reads on the elected subject matter.

The inventions are distinct, each from the other for the following reasons:

Inventions I and II are patentably distinct because the inventions are drawn to materially different compositions and methods that require different starting materials and modes of operation. The DNA construct of Group I is not required for the method of Group II. The method of making a retina-specific nuclear receptor knockout animal involves different steps than the method of identifying a retina-specific nuclear receptor expression modulator. Although the transgenic animal of Group I can be used in the method of Group II, it is not limited to this use. It can also be used to study the phenotype of retina-specific nuclear receptor gene disruption. Thus, the inventions of Group I are patentably distinct from the inventions of Group II.

Inventions I and III are patentably distinct because the inventions are drawn to materially different compositions and methods that require different starting materials and modes of operation. The DNA construct of Group I is not required for the method of Group III. The method of making a retina-specific nuclear receptor knockout animal involves different steps than the method of identifying a retina-specific nuclear receptor function modulator. Although the transgenic animal of Group I can be used in the method of Group III, it is not limited to this use. It can also be used to study the phenotype of retina-specific nuclear receptor disruption. Thus, the inventions of Group I are patentably distinct from the inventions of Group III.

Inventions I and IV are patentably distinct because the inventions are drawn to materially different compositions and methods that are not directly related. The DNA construct and

transgenic animal of Group I are chemically, biologically, and functionally distinct from the retina-specific nuclear receptor expression/function modulator of Group IV. The method of making DNA construct and knockout animal does not require the agent of Group IV. Thus, the inventions of Group I are patentably distinct from the inventions of Group IV.

Inventions I and V are patentably distinct because the inventions are drawn to materially different compositions and methods that require different starting materials and modes of operation. The DNA construct of Group I is not required for the method of Group V. The method of making a retina-specific nuclear receptor knockout animal involves different steps than the method of identifying an agent capable of ameliorate a eye abnormality. Although the transgenic animal of Group I can be used in the method of Group V, it is not limited to this use. It can also be used to study the phenotype of retina-specific nuclear receptor disruption. Thus, the inventions of Group I are patentably distinct from the inventions of Group V.

Inventions I and VI are patentably distinct because the inventions are drawn to materially different compositions and methods that are not directly related. The DNA construct and transgenic animal of Group I are chemically, biologically, and functionally distinct from the agent of Group VI. The method of making DNA construct and knockout animal does not require the agent of Group VI. Thus, the inventions of Group I are patentably distinct from the inventions of Group VI.

Inventions II and III are patentably distinct because the inventions are drawn to methods that require different starting material and modes of operation. The method of identifying a retina-specific nuclear receptor expression modulator involves different steps than the method of

identifying a retina-specific nuclear receptor function modulator. Thus, the inventions of Group II and III are patentably distinct.

Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the agent of Group IV can also be identified by other method, e.g. contacting a wild type cell with the agent and measure the retina-specific nuclear receptor expression. Thus, the inventions of Group II are patentably distinct from the inventions of Group IV.

Inventions II and V are patentably distinct because the inventions are drawn to methods that require different starting material and modes of operation. The method of identifying a retina-specific nuclear receptor expression modulator involves different steps than the method of identifying an agent that ameliorate an eye abnormality. Thus, the inventions of Group II and V are patentably distinct.

Inventions II and VI are patentably distinct because the inventions are drawn to methods and compositions that are not directly related. The methods of Group II cannot produce the agents of Group VI. Thus, the inventions of Group II and VI are patentably distinct.

Inventions III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the agent of Group IV can also be identified by other method, e.g. contacting a wild type cell with

the agent and determine whether the function of the retina-specific nuclear receptor is modulated. Thus, the inventions of Group III are patentably distinct from the inventions of Group IV.

Inventions III and V are patentably distinct because the inventions are drawn to methods that require different starting material and modes of operation. The method of identifying a modulator of retina-specific nuclear receptor function involves different steps than the method of identifying an agent that ameliorate an eye abnormality. Thus, the inventions of Group III and V are patentably distinct.

Inventions III and VI are patentably distinct because the inventions are drawn to methods and compositions that are not directly related. The methods of Group III cannot produce the agents of Group VI. Thus, the inventions of Group III and VI are patentably distinct.

Inventions IV and V are patentably distinct because the inventions are drawn to compositions and methods that are not directly related. The methods of Group V cannot produce the agents of Group VI. Thus, the inventions of Group IV and V are patentably distinct.

Inventions IV and VI are patentably distinct because the inventions are drawn to materially distinct compositions. The agents of Group IV are chemically, biologically and functionally distinct from the agent of Group VI. Thus, the inventions of Group IV are patentably distinct from the inventions of Group VI.

Inventions V and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the agent of Group VI can also be identified by other method, e.g. administering the agent to a

mouse with eye abnormality, and determine whether said agent ameliorates the eye abnormality.

Thus, the inventions of Group V are patentably distinct from the inventions of Group VI.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0823. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah J Clark can be reached on 703-305-4051. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Application/Control Number: 09/811,361

Page 8

Art Unit: 1633

Celine Qian, Ph.D
November 27, 2001



REMY YUCEL, PH.D
PRIMARY EXAMINER